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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,326	08/21/2003	Amel Amblard	8707-2161	7566

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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
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EXAMINER

KRAMER, NICOLE R

ART UNIT	PAPER NUMBER
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3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/645,326

Applicant(s)

AMBLARD, AMEL

Examiner

Nicole R. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-27 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 14 is/are rejected.
- 7) ☒ Claim(s) 4-7, 9-13 and 15-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/21/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 9/7/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending Application No. 10/645,329 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sun et al. (U.S. Patent No. 6,129,745).

Regarding application of Sun et al. to the original subject matter of claims 1-3, please see the Non-Final Rejection mailed 3/7/2006 at page 5.

Further, with regards to the added amended subject matter "means for automatic mode commutation," Sun et al. discloses the pacemaker includes means for adjusting the mode to a VDD mode (shown at step 52 of Figure 5A) during the test for determination of atrial undersensing. After the test is completed, the pacemaker then

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switches back to the DDD mode, where it had been operating prior to the test (see col. 10, lines 52-66).

With respect to the claim limitation that the conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode," Examiner notes that such a recitation is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the stimulation device of Sun et al. includes means for mode switching, it is considered capable of utilizing the detected conditions in order to prevent inappropriate switching to a DDD pacing mode.

4. Claim 14 stands rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (U.S. Patent No. 6,195,584).

Regarding application of Hill et al. to the original subject matter of claim 14, please see the Non-Final Rejection mailed 3/7/2006 at pages 5-6.

Further, with regards to the added amended subject matter "means for automatic mode commutation," Hill et al. discloses that the stimulation device checks to see if a mode switch operation (e.g., from an atrial synchronous to non-atrial synchronized pacing mode) is presently underway prior to performing the test for atrial lead dislocation (see col. 11, lines 15-20). From this disclosure of Hill et al., Examiner

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considers the stimulation device of Hill et al. to necessarily include "means for automatic mode commutation."

With respect to the claim limitation that the conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode," Examiner notes that such a recitation is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the stimulation device of Hill et al. includes means for mode switching, it is considered capable of utilizing the detected conditions in order to prevent inappropriate switching to a DDD pacing mode.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al., as applied above to claim 2, in view of Hill et al.

Regarding application of Sun et al. and Hill et al. to the original subject matter of claim 8, please see the Non-Final Rejection mailed 3/7/2006 at page 6.

Allowable Subject Matter

1. Claims 21-27 are allowed.
2. Claims 4-7, 9-13, and 15-20 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.
3. Please see the Non-Final Rejection mailed 3/7/2006 at pages 7-9 for the statement of reasons for the indication of allowable subject matter.

Response to Arguments

4. Applicant's arguments filed 9/7/06 have been fully considered but they are not persuasive. More specifically, Applicant argues that neither Sun et al. nor Hill et al. disclose any means for automatic mode commutation whereby such conditions are detected in order to prevent inappropriate switching to a DDD pacing mode (see page 10 of Response filed 9/7/06).

However, as described above, both references are considered to disclose such mode switching means. Further, with regards to the amended subject matter that the claimed conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode," Examiner notes that the recitation "in order to prevent inappropriate switching to a DDD pacing mode" is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the stimulation devices of Sun et al. and

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Hill et al. include means for mode switching, they are considered capable of utilizing the detected conditions in order to prevent inappropriate switching to a DDD pacing mode.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole R. Kramer whose telephone number is 571-272-8792. The examiner can normally be reached on Tuesdays and Fridays, 8 a.m. to 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRK

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3/20/2007


George Manuel
Primary Examiner